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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91208003
Party	Defendant Michael F. Ball
Correspondence Address	CASIMIR W COOK II ROYLANCE ABRAMS BERDO GOODMAN LLP 1300 19TH ST NW STE 600 WASHINGTON, DC 20036 1649 UNITED STATES CWCdocketing@roylance.com
Submission	Answer and Counterclaim
Filer's Name	Casimir W. Cook II
Filer's e-mail	CWCdocketing@roylance.com
Signature	/Casimir Cook/
Date	08/14/2013
Attachments	60080 - Answer Affirmative Defenses and Counterclaim - 8.14.13.pdf(114685 bytes )

Registration Subject to the filing

Registration No	3939863	Registration date	04/05/2011
International Registration No.	NONE	International Registration Date	NONE
Registrant	RED BULL GMBH Am Brunnen 1 5330 Fuschl am See, AUSTRIA		

Goods/Services Subject to the filing

Class 032. All goods and services in the class are requested, namely: energy drinks and soft drinks
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

<p>RED BULL GMBH,</p> <p style="text-align: center;">Opposer/Respondent,</p> <p style="text-align: center;">v.</p> <p>MICHAEL F. BALL,</p> <p style="text-align: center;">Applicant/Petitioner.</p>	<p>)</p> <p>)</p> <p>)</p> <p>)</p> <p>)</p> <p>)</p> <p>)</p> <p>)</p> <p>)</p>	<p>Opposition No. 91208003</p>
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**ANSWER AND AFFIRMATIVE DEFENSES TO AMENDED NOTICE OF  
OPPOSITION AND COUNTERCLAIM FOR CANCELLATION OF U.S. REG.NO. 3,939,863**

Michael F. Ball (“Applicant/Petitioner”) hereby answers the Amended Notice of Opposition in the above-identified proceeding as follows:

Applicant/Petitioner denies that Red Bull GmbH (“Opposer/Respondent”) will be damaged by the registration of its marks +RED DETOX ELIXIR, +RED DREAM ELIXIR, +RED SUN REPAIR ELIXIR, and +RED RESCUE ELIXIR shown in its U.S. Trademark Applications Serial Nos. 85/400,933, 85/400,941, 85/400,955 and 85/406,652 and answers the numbered paragraphs of the Amended Notice of Opposition as set forth below:

1. Applicant/Petitioner admits that Opposer/Respondent is engaged in the energy drink industry. Applicant/Petitioner lacks knowledge or information sufficient to form a belief as to the truth of the remaining allegations in numbered paragraph 1 of the Notice of Opposition and therefore denies same.
2. Applicant/Petitioner admits that Opposer/Respondent claims ownership of the corporate name, trade name and trademark RED BULL. Applicant/Petitioner lacks knowledge or information sufficient to form a belief as to the truth of the remaining allegations in the second numbered paragraph of the Amended Notice of Opposition and therefore denies same.
3. Applicant/Petitioner admits that the third numbered paragraph of the Amended Notice of Opposition purports to reflect U.S. Registration No. 3,939,863 as registered on April 5, 2011 for “energy

drinks and soft drinks,” in Int’l Class 32 and that Exhibit 1 purports to contain an excerpt from the USPTO’s TSDR database.

Applicant/Petitioner admits that the USPTO’s TSDR database identifies Opposer/Respondent as the current owner of Reg. No. 3,939,863, but lacks knowledge or information sufficient to form a belief as to the truth of the remaining allegations contained in the third numbered paragraph of the Amended Notice of Opposition and therefore denies the same.

4. Applicant/Petitioner admits that the fourth numbered paragraph of the Amended Notice of Opposition purports to reflect U.S. Registration No. 2,494,093 for “energy drinks and soft drinks,” in Int’l Class 32. Applicant/Petitioner admits that U.S. Registration No. 2,494,093 was registered on April 5, 2011, renewed on November 23, 2011 and that a Section 15 Declaration of Incontestability was acknowledged on December 29, 2012. Applicant/Petitioner also admits that Exhibit 1 purports to contain an excerpt from the USPTO’s TSDR database.

Applicant/Petitioner admits that the USPTO’s TSDR database identifies Opposer/Respondent as the current owner of Reg. No. 2,494,093, but lacks knowledge or information sufficient to form a belief as to the truth of the remaining allegations contained in the fourth numbered paragraph of the Amended Notice of Opposition and therefore denies the same.

5. Applicant/Petitioner admits that the fifth numbered paragraph of the Amended Notice of Opposition purports to reflect U.S. Registration No. 3,092,197 for “Non-alcoholic beverages, namely energy drinks and hypertonic drinks,” in Int’l Class 32. Applicant/Petitioner admits that U.S. Registration No. 3,092,197 was registered on May 16, 2006 and that a Combined Section 8 and 15 Declaration was accepted and acknowledged on March 10, 2012. Applicant/Petitioner also admits that Exhibit 1 purports to contain an excerpt from the USPTO’s TSDR database.

Applicant/Petitioner admits that the USPTO’s TSDR database identifies Opposer/Respondent as the current owner of Reg. No. 3,092,197, but lacks knowledge or information sufficient to form a belief as

to the truth of the remaining allegations contained in the fifth numbered paragraph of the Amended Notice of Opposition and therefore denies the same.

6. Applicant/Petitioner denies that Opposer/Respondent has any rights to its alleged RED mark. Applicant/Petitioner lacks knowledge or information sufficient to form a belief as to the truth of the remaining allegations contained in the sixth numbered paragraph of the Amended Notice of Opposition and therefore denies the same.

7. Applicant/Petitioner denies that Opposer/Respondent's alleged RED mark has been or is currently in use in interstate commerce. Applicant/Petitioner lacks knowledge or information sufficient to form a belief as to the truth of the remaining allegations contained in the seventh numbered paragraph of the Amended Notice of Opposition and therefore denies the same.

8. Applicant/Petitioner denies that the alleged RED mark is an asset of Opposer/Respondent and/or identifies Opposer/Respondent or Opposer/Respondent's goods. Applicant/Petitioner lacks knowledge or information sufficient to form a belief as to the truth of the remaining allegations contained in the eighth numbered paragraph of the Amended Notice of Opposition and therefore denies the same.

9. Applicant/Petitioner denies that the alleged RED mark is advertised by Opposer/Respondent in the United States and/or throughout the world. Applicant/Petitioner lacks knowledge or information sufficient to form a belief as to the truth of the remaining allegations contained in the ninth numbered paragraph of the Amended Notice of Opposition and therefore denies the same.

10. Applicant/Petitioner denies that any of Opposer/Respondent's 2012 sales are attributable to the alleged RED mark and that the alleged RED mark is famous. Applicant/Petitioner lacks knowledge or information sufficient to form a belief as to the truth of the remaining allegations contained in the tenth numbered paragraph of the Amended Notice of Opposition and therefore denies the same.

11. Admitted.

12. Admitted.

13. Admitted.

14. Admitted.

15. Admitted.

16. Applicant/Petitioner realleges and incorporates by reference its answers to numbered paragraphs 1-15 of the Amended Notice of Opposition.

17. Denied.

18. Denied.

19. Denied.

20. Denied.

21. Denied.

### **AFFIRMATIVE DEFENSES**

22. Opposer/Respondent's alleged RED mark lacks secondary meaning and is not a protectable trademark because Opposer/Respondent cannot show that the primary significance in the minds of the consuming public of the term "RED" when used in connection with "energy drinks and soft drinks" is not descriptive of an ingredient, quality, characteristic, function, feature, purpose, or use of the specified goods, but rather the source itself; therefore, Applicant/Petitioner is free to use and register the alleged trademark "RED" in commerce as a literal element of +RED DETOX ELIXIR, +RED DREAM ELIXIR, +RED SUN REPAIR ELIXIR, and +RED RESCUE ELIXIR.

23. Opposer/Respondent's marks pled in its Notice of Opposition ("Opposer/Respondent's Marks") are diluted and therefore weak and entitled to only a narrow scope of protection, if any, because numerous third parties have used, applied to register and registered in the USPTO marks and other designations comprising or incorporating the letters RED, including the use, and application for registration and registration in the USPTO of such marks in connection with goods and/or services commercially related to Opposer/Respondent's Marks. Accordingly, given the distinct differences in the marks at issue in this proceeding. Opposer/Respondent's Marks are not entitled to a scope of protection sufficiently broad so as to encompass Applicant/Petitioner's opposed marks.

**COUNTERCLAIM - PETITION FOR CANCELLATION OF U.S. REG. NO. 3,939,863**

24. Applicant/Petitioner hereby realleges and restates paragraphs 1 - 23 above as if fully set forth herein.

25. Applicant/Petitioner, Michael F. Ball, a United States individual, having a principal place of business at 145 Channel Pointe Mall, Marina Del Rey, CA 90292 believes that it is and/or will be damaged by United States Trademark Registration No. 3,939,863, owned by Opposer/Respondent, Red Bull GmbH, for RED which was registered on the Principal Register on April 5, 2011, and currently covers “energy drinks and soft drinks” in Int’l Class 32 (the “Registration”), and pursuant to Rule 2.111 of the Trademark Rules of Practice, hereby petitions for the cancellation thereof.

The specific grounds for cancellation are as follows:

26. Applicant/Petitioner is the record owner of United States Service Mark Application Nos. 85/400,933, 85/400,941 and 85/400,955, filed on August 18, 2011, and 85/406,652, filed on August 24, 2011, for the marks +RED DETOX ELIXIR, +RED DREAM ELIXIR, +RED SUN REPAIR ELIXIR, and +RED RESCUE ELIXIR, all for goods identified as “non-alcoholic beverages, namely, carbonated beverages” in Int’l Class 32. Opposer/Respondent has opposed these applications on the grounds of a likelihood of confusion, in part, with U.S. Registration No. 3,939,863 (the “Registration”) under Section 2(d) of the Trademark Act of 1946, as amended. Applicant/Petitioner is also the record owner of U.S. Trademark Application Serial Nos. 85/351,186 and 85/346,334 for the marks +RED Stylized & Design, which have been refused registration, in part, on the grounds of a likelihood of confusion the Registration under Section 2(d) of the Trademark Act of 1946, as amended. The appeals for U.S. Trademark Application Serial Nos. 85/351,186 and 85/346,334 are suspended pending the disposition of these proceedings.

27. Upon information and belief, Opposer/Respondent has abandoned the RED mark within the purview of Section 45 of the U.S. Trademark Act, 15 U.S.C. §1127.

28. Upon information and belief, Opposer/Respondent has never and is no longer using the RED mark on the goods covered by the Registration.

29. Upon information and belief, Opposer/Respondent has no intent to resume use of the RED mark in connection with the goods covered by the Registration.

30. Upon information and belief, Opposer/Respondent has discontinued use of the RED mark in connection with the goods covered by the Registration, causing the mark to lose significance as an indication of origin.

31. Upon information and belief, Opposer/Respondent is also the owner of U.S. Trademark Application No. 85/438,268 – RED, filed on October 3, 2011, based on use since August 29, 2011, for “energy drinks; soft drinks; hypertonic drinks.”

32. On October 3, 2011, Opposer/Respondent submitted as a specimen of use supporting U.S. Trademark Application No. 85/438,268 the image in Figure 1 below:



**Figure 1.**

33. On December 23, 2011, the USPTO issued a non-final office action (1) indicating that the specimen was unacceptable as it did not support use of the alleged RED mark; (2) seeking information on the significance of the term RED; and (3) indicating a potential suspension based on Applicant/Petitioner’s U.S. Trademark Application Serial Nos. 85/351,186 and 85/346,334.

34. On June 20, 2012, Opposer/Respondent submitted arguments in favor of its specimen from Figure 1, providing limited information to the USPTO on the significance of the term RED, and arguing against suspension.

35. On July 13, 2012, the USPTO issued a Notice of Suspension (1) suspending Opposer/Respondent's U.S. Trademark Application No. 85/438,268 – RED pending the disposition of Applicant/Petitioner's prior pending U.S. Trademark Application Serial Nos. 85/351,186 and 85/346,334; (2) maintaining and continuing the refusal of the specimen in Figure 1 as representing the THE RED EDITION mark and not the alleged RED mark; and (3) indicating that the response to the significance inquiry (which did not identify the product in Figure 1 as artificially cranberry flavored or containing red colored liquid) was satisfactory.

36. Upon information and belief, apart from use as an element of the composite mark RED BULL, Opposer/Respondent's only other use of the literal element RED in commerce in connection with beverages is as an element of the composite designation THE RED EDITION.

37. Upon information and belief, Opposer/Respondent's THE RED EDITION energy drinks and soft drinks are advertised as including "the taste of cranberry."

38. Upon information and belief, Opposer/Respondent's THE RED EDITION energy drinks are actually a red colored liquid.

39. Opposer/Respondent's alleged RED mark, subject of the Registration, is merely descriptive under Section 2(e) of the Trademark Act, 15 U.S.C. §1052(e), in that Opposer/Respondent's alleged RED mark identifies and/or describes an ingredient, quality, characteristic, function, feature, purpose, of Opposer/Respondent's red colored and cranberry flavored "energy drinks and soft drinks."

40. Continued registration of the mark shown in the Registration will result in damage to Applicant/Petitioner pursuant to the allegations stated above, and will create a cloud on the lawful right of Applicant/Petitioner to adopt, use and register the marks +RED DETOX ELIXIR, +RED DREAM ELIXIR, +RED SUN REPAIR ELIXIR, +RED RESCUE ELIXIR, and Applicant/Petitioner's prior pending U.S. Trademark Application Serial Nos. 85/351,186 and 85/346,334, *et al.*, and will hinder or prevent Applicant/Petitioner from obtaining federal registration of these marks in the name of the Applicant/Petitioner.



41. In view of the foregoing, U.S. Registration No. 3,939,863 is subject to cancellation and Applicant/Petitioner asks that it be cancelled pursuant to Sections 14(1) and 14(3) of the U.S. Trademark Act, 15 U.S.C. §1064(1) and (3) on the grounds of abandonment under Section 45 of the U.S. Trademark Act, 15 U.S.C. §1127 and under Section 2(e) of the U.S. Trademark Act, 15 U.S.C. §1052(e), on the grounds of mere descriptiveness.

42. This Petition for Cancellation is submitted, together with \$300.00 in payment of the statutory filing fee.

\* \* \* \* \*

**WHEREFORE**, Applicant/Petitioner prays as follows:

- (a) that this Opposition be dismissed;
- (b) that the opposed Application Serial Nos. 85/400,933, 85/400,941, 85/400,955 and 85/406,652 proceed to allowance; and
- (c) that the Petition to Cancel U.S. Registration No. 3,939,863 be sustained and the Registration be cancelled.

Respectfully submitted,

MICHAEL F. BALL



Date: August 14, 2013

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Casimir W. Cook II  
Counsel for Applicant/Petitioner  
Roylance, Abrams, Berdo  
& Goodman, L.L.P.  
1300 19<sup>th</sup> Street, N.W.  
Suite 600  
Washington, DC 20036-1649  
Office: (202) 659-9076  
Fax: (202) 659-9344  
ccook@roylance.com

**CERTIFICATE OF SERVICE**

I hereby certify that a copy of the foregoing ANSWER AND AFFIRMATIVE DEFENSES TO AMENDED NOTICE OF OPPOSITION AND COUNTERCLAIM FOR CANCELLATION OF U.S. REG.NO. 3,939,863 has been served by first-class mail, postage prepaid, on counsel for Opposer/Respondent, as follows, this 14th day of August 2013 as follows:

Martin R. Greenstein  
TechMark a Law Corporation  
4820 Harwood Road, 2<sup>nd</sup> Floor  
San Jose, CA 95124



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Casimir W. Cook II